

REMARKS

Claims 1-31 are pending in this application. Claims 1-23 and 27-31 have been withdrawn from consideration. By this Amendment, claims 1, 3-6, 8-14, 16, 19 and 24-28 are amended. Support for the amendments can be found, for example, in the specification and the claims as originally filed (see page 12, lines 16-32; page 14, lines 1-3; and page 17, lines 11-14). No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments:

(a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

In view of the foregoing amendments and the following remarks, reconsideration and allowance of the claims are respectfully requested.

I. Rejection Under 35 U.S.C. §102

The Patent Office rejects claims 24-26 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,725,906 to Allen ("Allen"). This rejection is respectfully traversed.

Claim 24 recites, *inter alia*: " A process for preparing a composition...wherein the at least one polymeric thixotropic agent **B** prepared by homopolymerizing a (meth)acrylate **B1** or by copolymerizing the (meth)acrylate **B1** with at least one further (meth)acrylate to form a (meth)acrylate mixture; wherein...the (meth)acrylate mixture has an average (meth)acrylate functionality *f* of 2.5 to 4.5; and wherein the (meth)acrylate **B1** has three or more

(meth)acrylate groups, does not contain groups that react with an NCO, an epoxide group, or an alkoxy silane group, and is selected from the group consisting of glycerol tri(meth)acrylate, tris(2-hydroxyethyl)isocyanurate tri(meth)acrylate, ditrimethylolpropane tetra(meth)acrylate, pentaerythritol tetra(meth)acrylate, glucose penta(meth)acrylate, sorbitol hexa(meth)acrylate, dipentaerythritol hexa(meth)acrylate, and their ethoxylated or propoxylated analogs." Allen does not disclose the subject matter recited in claim 24.

Allen discloses to a two-phase mixture comprising a solid particulate component and a liquid component (Allen, col. 4, lines 21-24). The Patent Office interprets the solid component and the liquid component of Allen as allegedly corresponding to component **A** and component **B**, respectively, as recited in claim 24 (Office Action, page 2). As to component **B1** of claim 24, Allen discloses trimethylolpropane trimethacrylate (TMP-TMA) and gamma-methacryloxypropyl-trimethyloxysilane (Allen, col. 13, lines 10-15; col. 16, lines 51-55 and Table 3).

It is well settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. See MPEP §2131. Based on the above, because Allen merely discloses trimethylolpropane trimethacrylate (TMP-TMA) and gamma-methacryloxypropyl-trimethyloxysilane, Allen fails to disclose a component **B1** that has three or more (meth)acrylate groups, does not contain groups that react with an NCO, an epoxide group, or an alkoxy silane group, and is selected from the group of compounds recited in claim 24 (Allen, col. 13, lines 10-15).

In view of the foregoing, Allen fails to disclose, and thus does not anticipate, each and every feature of claim 24. Claims 25 and 26 depend from claim 24 and, likewise, are not anticipated by Allen for at least the reasons set forth above with respect to claim 24, as well as for the additional features recited therein.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejoinder

Applicant also respectfully requests rejoinder of non-elected product claims 1-23, 30 and 31 and process claims 27-29.

It is respectfully submitted that the subject matter of all the claims is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, Applicant respectfully submits that the search and examination of the entire application could be made without serious burden. *See MPEP §803* in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). Applicant respectfully submits that this policy should apply in the present application to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Accordingly, withdrawal of the Restriction Requirement and rejoinder of claims 1-23 and 27-31 are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-31 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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